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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,328	10/07/2004	Bardo Schmitt	259240US0PCT	1797
22850	7590	05/31/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			PEZZUTO, HELEN LEE	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/509,328

Applicant(s)

SCHMITT ET AL.

Examiner

Helen L. Pezzuto

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/7/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant's amendment to claims 1-10, and the addition of claims 11-20 filed in the preliminary amendment on 10/7/04 is acknowledged. Currently, claims 1-20 are pending in this application.

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 10/7/04 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bader et al. (US-379) in view of FR 2771411 (with respect to claims 8 and 20).

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US 5,384,379 to Bader et al. discloses method of making sulfur-containing poly(meth)acrylate derived from free radical polymerization of sulfur-containing (meth)acrylate monomers set forth in formulas (I) and (II) in the presence of inert organic solvent L at 40-90°C. Prior art monomers (I) and (II) fall within the scope of the instant (I) and (II) compounds. Specifically, n in prior art (II) has a value of 1-6, which meets the instant requirement of $m+n > 0$. Prior art sulfur-containing monomers is derived from the reaction of (III) and (IV) as presently claimed (col. 2, lines 10-68). The admixture of (III) and (IV) in a base to form V, prior to the polymerization is also taught, which embrace applicant's embodiment expressed in claims 12-20. Prior art essentially employ identical process conditions as presently claimed, with the slight difference in number mole of (III). Patentees use at least two moles of (III) to react with one mole of (IV), whereas applicants use one to less than two moles of (III) to react with one mole of (IV). The examiner is of the position that when the claimed range and the prior art range are very similar (i.e. less than two vs. two), the range of the prior art establishes prima facie obviousness because one of ordinary skill in the art would

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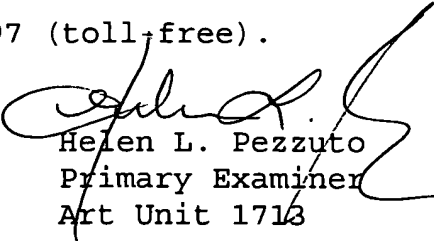
have expected the closely similar ranges to have the same or essentially the same properties. Applicants' comparative data of record have been fully considered, but are not found to be clear and convincing with respect to criticality of molar ratios of (III) and (IV). The comparative showings of record are not conducted in a side-by-side manner, with many variables contained therein (i.e. reaction solvent, mol of NaOH, reaction temperature). It is not clear where the unexpected results lie in applicants' process as compared to prior art process. Furthermore, in order to overcome a reasonable case of prima facie obviousness, a given claim must be commensurate in scope with any showing of unexpected results. US-379 is silent regarding the use of an acidic ion exchanger as expressed in claims 8 and 20. The employment of such, is expressly taught in FR-411 in a closely analogous process of making dithioester as defined in the instant (I) derived from (III) and (IV). Accordingly, one of ordinary skill in the art would readily envisage using the acidic ion exchanger catalyst expressly taught in FR-411 in the process of US-379, motivated by the reasonable expectation of success of minimizing the occurrence of post-reaction treatment required in conventional processes.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen L. Pezzuto whose telephone number is (571) 272-1108. The examiner can normally be reached on 8 AM to 4 PM, Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Helen L. Pezzuto
Primary Examiner
Art Unit 1713

hlp